

invention set forth in claim 16. Inasmuch as claim 16 has already been examined, it is respectfully submitted that the examination of its dependent claim 17 would not represent a serious burden in this matter. With regard to this, it is noted that MPEP §803 specifically states:

"[I]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

As such, since claim 17 is dependent on claim 16 which has already been searched and examined, it is respectfully requested that claim 17 also be examined in accordance with the guidelines set forth in MPEP §803.

Beyond this, for reasons discussed below, it is respectfully submitted that claim 16 is in condition for allowance over the cited prior art. If the Examiner agrees with this following a review of the following comments, it is respectfully requested that claim 17 be allowed with claim 16 in light of the dependency of claim 17 on claim 16. Applicants and the undersigned attorney greatly appreciate the Examiner's review and consideration in this regard.

Turning to the rejection set forth in the Office Action, reconsideration and allowance of claims 1-16 over the rejections based on USP 5,724,544 to Nishi and USP 6,826,113 to Ellis is respectfully requested. With regard to this, it is noted that both of the independent claims 1 and 16 include the feature that a second erase command is sent by the control module to a plurality of non-volatile semiconductor memories while other non-volatile semiconductor memories are still under a first internal erase operation responsive to a first erase command. In other words, independent claims 1 and 16 both define arrangements in which two separate erase operations of different non-volatile semiconductor memories are interleaved with one another.

In the Office Action, it is recognized at the bottom of page 3 that "Nishi does not teach initiating the second erase command while the first erase operation is still being performed in the first non-volatile memory." However, the Office Action goes on to cite Ellis for performing operations in parallel. Based upon this, the Office Action concludes at the top of page 4, that it would be obvious to modify the system of Ellis to perform erase operations in parallel in light of the teachings of Ellis "in order to ensure minimum memory latency."

With regard to this, applicants respectfully note that, although Ellis does discuss performing operations in parallel, Ellis fails to teach or suggest carrying out erase operations for different non-volatile semiconductor memories in parallel. Instead, the operations discussed by Ellis in column 2, lines 10-16 pertain to carrying out command and address ECC (Error Correction Code) operations in parallel with a normal memory re-drive method. This is substantially different than the parallel erase operations required by both of the independent claims 1 and 16.

With regard to this, attention is directed to MPEP §2143.01 which states:

"Obviousness can only be established by combining or modifying the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

In the present instance, the parallel operations taught by Ellis are completely different than the erase operation of Nishi. As such, neither Nishi nor Ellis teach or suggest carrying out parallel erase operations for different non-volatile semiconductor memories. Therefore, the requirement of "some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves" clearly does not apply to the references under consideration.

With regard to "knowledge generally available to one of ordinary skill in the art" MPEP §2144.03 specifically states:

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based."

In addition, MPEP §2144.03 also states:

"Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known."

It is respectfully submitted that the rejections set forth in the Office Action goes against both of the above-noted requirements of MPEP §2144.03. In the first place, the rejection does rely solely on common knowledge in the art without evidentiary support as the principal evidence since, as noted above, the references themselves neither implicitly or explicitly provide the necessary motivation for the proposed modification. In addition, it is respectfully submitted that the proposed modification is certainly not "capable of instant and unquestionable demonstration as being well-known." Therefore, reconsideration and removal of the rejection based upon the requirements of MPEP §2143.01 and §2144.03 is earnestly solicited.

In addition, the Examiner's attention is directed to the CAFC Decision in *in Re Lee*, 61 USPQ 2d 1430. In that case, the CAFC addressed a combination of two references, similar to the present situation, based upon conclusory statements by the Examiner as to why the combination would be obvious. In particular, the Court stated:

"With respect to Lee's application, neither the Examiner nor the Board adequately supported the selection and combination of the Northrup and Thunderchopper references to render obvious that which Lee described.

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "use that which the inventor taught against its teacher." 61 USPQ 2d at 1434.

It is respectfully submitted that the present combination of Nishi and Ellis falls within the holding of the CAFC in the in Re Lee case. The statement set forth in the Office Action that the substantial modification in Nishi utilizing Ellis would be performed "in order to ensure minimum memory latency" is the same type of "subjective belief and unknown authority" addressed as being improper in the in Re Lee Decision. Accordingly, reconsideration and allowance of the independent claims 1 and 16, and their respective dependent claims is again requested based both upon the requirements of the MPEP, noted above, as well as the holding in the in Re Lee Decision.

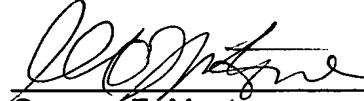
If the Examiner believes that there are any matters which can be resolved by way of either a personal or telephone interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

Applicants request any shortage or excess in fees in connection with the filing of this paper, including extension of time fees, and for which no other form of

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payment is offered, be charged or credited to Deposit Account No. 01-2135 (Case: 566.32253CC8).

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP.

A handwritten signature in black ink, appearing to read "Gregory E. Montone", is written over a horizontal line.

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